

**Amendment and Response**

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Serial No.: 09/626,621

Confirmation No.: 2487

Filed: 27 July 2000

For: GRAPHIC IMAGE FILM REGISTRATION SYSTEMS AND METHODS

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**Remarks**

The Office Action mailed 10 December 2002 has been received and reviewed. Claims 26-33 have been canceled and new claims 34-47 have been presented, leaving claims 1-25 and 34-47 pending. Reconsideration and withdrawal of the rejections are respectfully requested.

**AFFIRMATION OF PROVISIONAL ELECTION**

The Examiner issued a Restriction Requirement under 35 U.S.C. § 121 in the above-identified application, grouping the claims as follows: Group I, Claims 1-25 drawn to a method of providing a composite image on a substrate, and Group II, Claims 26-33 drawn to an image graphic kit. A provisional election to prosecute claims 1-25, Group I, was made in response to a telephone conversation between Applicants' Representative, Kevin W. Raasch, and Examiner Purvis on 3 December 2002. The provisional election to prosecute Group I is herein affirmed without traverse.

Non-elected claims 26-33 have been canceled without prejudice.

**New Claims 34-47**

New claims 34-47 are presented herein for consideration. Support for the claims can be found in the application as filed. For example, new independent claim 34 is supported at, e.g., p. 11, lines 7-12. New independent claim 44 is supported at, e.g., p. 13, lines 10-22. New independent claim 47 is supported at, e.g., p. 7, lines 3-27. Applicants respectfully submit that new claims 34-47 are patentable as presented.

**The 35 U.S.C. §103 Rejections**

Claims 1-6 and 9-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513).

Applicants respectfully traverse the rejection of independent claims 1 and 23 because the cited documents fail to support a proper *prima facie* case of obviousness as follows.

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The Office Action relies upon the asserted admitted prior art in view of Krawczyk and Jensen in rejecting claims 1 and 23. The Office Action asserts that all the elements necessary to arrive at a *prima facie* case of obviousness against claims 1 and 23 are present in the combination of the asserted admitted prior art, Krawczyk, and Jensen.

The Office Action, however, fails to identify a proper suggestion or a motivation as to why one skilled in the art would have chosen to modify the asserted admitted prior art in view of both Krawczyk and Jensen that is supported by the cited references as discussed in Applicants' response dated March 21, 2002.

Briefly, Applicants noted that the cited documents failed to support the asserted suggestion or motivation to modify or combine the reference teachings because the proposed combination would change the principle operation of the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (MPEP § 2143.01). Applicants were not, as asserted, attacking the references individually. Rather, Applicants pointed out that one skilled in the art would not have been motivated to look to the asserted combination of the asserted admitted prior art, Krawczyk and Jensen, as the combination of these documents would change the principle operation of the invention being modified as discussed in that response.

In the absence of a properly supported suggestion or motivation to combine all three reference teachings, the only way of arriving at the claimed subject matter is by picking and choosing individual elements from Krawczyk and Jensen based on Applicants' disclosure. Nothing in the cited reference teachings would direct or motivate one skilled in the art to combine these three reference teachings as asserted in the absence of Applicants' own disclosure.

For the above reasons, Applicants respectfully request reconsideration and withdrawal of this rejection as applied to claims 1-6 and 9-23. The rejections and/or assertions regarding specific claims or groups of claims are also addressed in more detail below.

With respect to claim 2, the rejection is premised on the manual tensioning of the asserted admitted prior art, as modified by the teachings of Jensen. The Office Action fails, however, to

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provide any reasoning as to why or how one of skill in the art would make the leap from a manual, panel-by-panel installation technique in which tension is sporadically applied in a variety of directions (e.g., across the width and length of each panel) to a method in which tension is applied only along the length of the film. In the absence of any identified suggestion or motivation to make that modification, it must be assumed that impermissible hindsight forms the basis for the rejection of claim 2. As such, a proper *prima facie* case of obviousness for claim 2 has not been established.

With respect to claim 6, Applicants note that none of the cited references teach removal of registration marks from a film. Any assertion that Krawczyk teaches removal of guidelines from a film is not supported by the reference itself. In that regard, Applicants note that the section cited in support of the rejection of claim 6 (i.e., Col. 16, lines 43-47) teaches removing marks from the tiles, not the film as recited in the claims.

With respect to claims 10 and 12, Applicants traverse the assertion that Krawczyk supports the rejection. The washable registration marks of Krawczyk are found on the tiles, not the plastic sheet itself.

With respect to claim 18, any assertion that Jensen teaches alignment of the width (transverse to the length) is misplaced because Jensen teaches application of a single web to the paper backing, thus eliminating any need to align two films across their width on a substrate. Furthermore, Applicants note that claim 18 recites detection of the distance between the leading edge and trailing edge of a registration mark and uses that measurement to align the films across their width. It may be helpful if the portion of the specification (p. 7, lines 3-27 and FIG. 1A) describing implementation of this concept is reviewed. As discussed above, Jensen provides no motivation or suggestion to employ registration marks to align a film in a direction transverse to its length.

With respect to claim 19 which recites "applying the first film to the substrate under tension," Applicants traverse the Office Action assertion that the asserted admitted prior art teaches that first film is stretched or pulled during application. The first film need not be registered during application to a substrate in the prior art method because it is the first film, i.e.,

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there are no other films to which the first film must be registered. As a result, any assertion that the limitations of claim 19 are taught in the prior art is misplaced.

For the above reasons, Applicants respectfully submit that claims 1-6 and 9-23 are patentable over the cited references (the asserted admitted prior art, Krawczyk, and Jensen). Reconsideration and withdrawal of the rejection of these claims are, therefore, respectfully requested.

Although not explicitly stated, it appears that claims 7 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513), and further in view of Hensley et al. (U.S. Patent No. 6,354,984 B1).

Claims 7 and 24 recite "removing a portion of the second film." It is asserted in the Office Action that one would remove the second registration marks from the second film under a variety of circumstances. None of the assertions are, however, supported by a reference to the prior art. An attempt is made to rely on the teachings of Krawczyk in which the entire film is removed, with an assertion that because Krawczyk teaches removal of the entire plastic sheet, "it is the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan." *Office Action*, p. 6.

That modification would, however, would require a change in the principle operation of the prior art invention being modified. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious (MPEP § 2143.01). The plastic sheets of Krawczyk are used only as carriers. To leave a portion of the plastic sheet attached to the tiles would change the nature of the Krawczyk invention. For example, the plastic sheet remaining on the tiles would prevent the proper application of grout to the spaces between the tiles. As a result, any reliance on the teachings of Krawczyk as support for the removal of a portion of the film is misplaced.

The discussion regarding claims 7 & 24 also refers to Hensley et al. There is, however, no discussion in the Office Action as to how one of ordinary skill in the art would apply the

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principles taught in Hensley et al. to any of the other cited references to reach the present invention.

For the above reasons, Applicants respectfully submit that claims 7 & 24 are patentable over the cited references (the asserted admitted prior art, Krawczyk, Jensen, and Hensley et al.). Reconsideration and withdrawal of the rejection of these claims are, therefore, respectfully requested.

Claims 8 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513) as applied to claims 1, 5-7, 23, and 24, and further in view of Shannon (U.S. Patent No. 4,806,184) or Fritz (U.S. Patent No. 1,498,618). Mitchell (U.S. Patent No. 4,490,198) is also mentioned, but it is unclear as to whether it is relied on in support of the rejection. Clarification is requested.

The discussion regarding this rejection does not address a basic issue surrounding removal of the portion of the second film containing the registration marks "before the second film is applied to the substrate" as recited in claims 8 and 25. Removal of the registration marks before application of the second film raises issue as to how the registration can be accomplished (because there are no registration marks remaining on the film). In fact, removal of the registration marks would contradict the teachings of one of the primary references relied on in support of this rejection. Jensen, Jr. teaches that the registration marks 19 on its film are sensed after laminating the film to the paper backing to ensure proper registration. See, e.g., Col. 9, lines 36-41. Removal of the registration marks before applying the film to the paper backing would frustrate that purpose and could result in mis-alignment of the film on the paper backing. The Office Action does not, however, address this issue and Applicants submit that one of ordinary skill in the art would not be motivated to remove registration marks before applying the second film in view of the teachings of Jensen, Jr. to the contrary. The newly cited references (Shannon and Fritz) do not address this basic issue with respect to claims 8 and 25.

For the above reasons, Applicants respectfully submit that claims 8 & 25 are patentable over the cited references (the asserted admitted prior art, Krawczyk, Jensen, and Hensley et al.).

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Reconsideration and withdrawal of the rejection of these claims are, therefore, respectfully requested.

Claims 9 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513) as applied to claim 1, and further in view of Easter (U.S. Patent No. 4,620,888) or Roch (U.S. Patent No. 5,138,667).

Applicants note, however, that dependent claims 9 and 11 are patentable for at least the reasons presented with respect to independent claim 1. The addition of Easter or Roch et al. does not address the basic deficiencies of the rejection of claim 1. As a result, Applicants respectfully submit that claims 9 and 11 are patentable as presented. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

Claims 21 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Krawczyk (U.S. Patent No. 5,252,166) and Jensen, Jr. (U.S. Patent No. 4,795,513) as applied to claim 1, and further in view of Shannon (U.S. Patent No. 4,806,184).

Applicants note, however, that dependent claims 21 and 22 are patentable for at least the reasons presented with respect to independent claim 1. The addition of Shannon does not address the basic deficiencies of the rejection of claim 1. As a result, Applicants respectfully submit that claims 21 and 22 are patentable as presented. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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**Summary**

It is respectfully submitted that pending claims 1-25 and 34-47 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for  
Conrad V. ANDERSON et al.

By  
Mueting, Raasch & Gebhardt, P.A.  
P.O. Box 581415  
Minneapolis, MN 55458-1415  
Phone: (612) 305-1220  
Facsimile: (612) 305-1228

09 APRIL 2003

Date

By: KW Raasch

Kevin W. Raasch  
Reg. No. 35,651  
Direct Dial (612)305-1218

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GROUP 1700

**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 9th day of April, 2003, at 11:25 a.m. (Central Time).

By: Conrad V. Anderson - GebhardtName: Conrad V. Anderson - Gebhardt